

Application No.: 10/662,851
Response to Restriction Requirement dated April 7, 2006
Office Action dated March 8, 2006

REMARKS

Applicants acknowledge receipt of the Office Action dated March 8, 2006. As is detailed more thoroughly below, Applicants provisionally elect claims 1-29 for further prosecution on the merits, with traverse, thereby preserving the right to petition the Commissioner for review of any final restriction requirement. Therefore, claims 1 – 29 and 32 – 43 are currently pending. Claims 30 and 31 were cancelled in Applicants' previous response dated March 25, 2005. Claims 32 – 43 are provisionally withdrawn. In view of the following remarks, Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

In the Office Action, the Examiner requires an election under 35 U.S.C. § 121 and MPEP § 806.05(d) between the following alleged subcombinations:

- I. Claims 1-29; and
- II. Claims 32-43.

Applicants respectfully traverse this rejection.

Standard for Requiring Restriction Not Met

The standard for properly requiring a restriction includes two prongs. First, the claimed inventions must be independent or distinct; and, second, there must be a serious burden on the examiner if restriction is required. MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to distinct or independent inventions.

(emphasis added).

Without conceding the merits of the Examiner's allegation that the subject matter of the claims includes multiple subcombinations, Applicants respectfully traverse the restriction requirement as failing to satisfy the second prong outlined above, which includes the serious burden element. Applicants respectfully submit that the Examiner has provided no evidence, or even an allegation, that a search and examination of the entire application as is presently before the Patent Office, would be a *serious burden* on the Examiner. Instead, the Office

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Action merely alleges that the two sets of claims are independent or distinct, as including multiple subcombinations, which, if true, only satisfies the first prong of the above-described two-prong restriction standard.

Furthermore, MPEP § 808.02 states that “[w]here the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon the restriction, must show by appropriate explanation one of the following.”

- (A) Separate classification;
- (B) Separate status in the art when they are classifiable together; or
- (C) Different field of search.

Notwithstanding the Examiner’s alleged finding of multiple subcombinations, Applicants submit that because the Examiner’s restriction requirement is based on MPEP § 806.05(d), the above-described MPEP § 808.02 expressly applies. Specifically, even if the Examiner successfully establishes that the invention claimed in claims 1-29 is independent or distinct from the invention claimed in claims 32-43 of the present application, neither (A), (B), nor (C) of MPEP § 808.02 is satisfied.

First, Applicants respectfully submit that MPEP § 808.02(A) is not satisfied. The Examiner admits in the Office Action that the claims subject to the restriction requirement are not separately classified, as is required by MPEP § 808.02(A). Specifically, the Examiner states that both sets are classified in class 156, subclass 523.

Next, Applicants respectfully assert that MPEP § 808.02(B) is not satisfied. MPEP § 808.02 states that “[e]ven though [the claims] are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.” Applicants respectfully assert that the Examiner has provided no such explanation. Rather, the Examiner merely makes the conclusive statement that the “inventions...have acquired a separate status in the art because of their divergent subject matter...” Applicants respectfully submit that such a conclusive statement fails to provide the “explanation indicat[ing] a recognition of separate inventive effort,” as is required under MPEP §

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808.02(B). Furthermore, Applicants respectfully submit that the Examiner has not cited any patents or identified a separate field of search, which may also form the basis for this explanation. Therefore, Applicants respectfully assert that the Examiner has failed to explain how the claims occupy separate statuses in the art as is required under MPEP § 808.02(B).

Finally, Applicants respectfully assert that MPEP § 808.02(C) is not satisfied. Specifically, MPEP § 808.02(C) states, “[w]here it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the [claims] are classified together.” Applicants respectfully assert that the present claims fail to occupy such different fields of search. Specifically, each of the claims subject to the restriction requirement are directed to similar devices having similar components and a complete search directed to the subject matter of claims 1-29 would require a search directed to the subject matter of claims 32-43. Similarly, a complete search directed to the subject matter of claims 32-43 would require a search directed to the subject matter of claims 1-29. Therefore, Applicants respectfully request reconsideration and withdrawal of this restriction requirement.

Accordingly, Applicants respectfully submit that a search and examination of the entire patent application can be made without serious burden on the Examiner because all of the claims in the application are commonly classified, they do not occupy separate statuses in the art, and they do not require different fields of search. Additionally, Applicants submit that it would be wasteful of the time, effort, and resources of both the Applicants and the Patent Office to prosecute these claims in separate applications. Search and examination of the alleged sub-combinations together would be much more efficient than requiring the Patent Office and the Applicant to do so separately.

Provisional Election

In accordance with 37 CFR 1.143, Applicants hereby provisionally elect to prosecute claims 1-29, with traverse. In making this provisional election, Applicants do not intend to abandon the scope of the non-elected claims as originally filed, but may, if required, choose to pursue them either by petition for further review or in a divisional application in the event the Examiner chooses to make the restriction requirement final.

Conclusion

Applicants believe that all outstanding rejections and/or concerns have been either traversed, accommodated, or rendered moot and, therefore, request prompt and favorable consideration of this application. In the event the Examiner believes there is any outstanding issue that may be resolved via telephone conference, Applicants hereby invite the Examiner to telephone the undersigned at (312) 474-6300.

Dated: April 10, 2006

Respectfully submitted,

By _____

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